

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-32 and 34-53 remain in this application. Claim 33 has been canceled. Claim 54 has been added.

Regarding new claim 54, support for the claim language regarding the storage of a picture of a member as an identification characteristic is found on the last paragraph of page 8 of the specification, and the claim language specifying that this identification characteristic is sent to other members is found in the first full paragraph of page 9.

Claim 52, 53 were rejected under 35 U.S.C. §102(e) as being anticipated by Fraccaroli (U.S. Pat. App. 2004/0002348). Claims 1-4, 10-15, 29-32 and 34-47 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fraccaroli (U.S. Pat. App. 2004/0002348) in view of Herz (U.S. 6,571,279). The remaining claims were rejected under 35 U.S.C. §103(a) as being unpatentable over Fraccaroli and Herz in view of various other additional cited references. For the following reasons, the rejections are respectfully traversed.

Regarding the rejection of claims 1-32 and 34-53, a Declaration under 37 CFR 1.131 Establishing Prior Invention has been executed by the inventors and was provided with the immediately preceding amendment. This declaration states, and provides documentary evidence to support, that the invention, as reflected in the amended claims provided in this response, was within the possession of the inventors prior to the date of May 19, 1999. Thus, the invention predates the filing dates of both Fraccaroli (having a priority date of August 24, 1999) and Herz (having a filing date of May 19, 1999). Please note that Herz is a CIP of earlier filed applications, and thus it cannot be assumed that the disclosures of these earlier filed applications support the teachings cited by the Examiner. Accordingly, neither Fraccaroli nor Herz are properly considered prior art, and thus the rejections cannot stand and must be withdrawn.

The Examiner has improperly dismissed this declaration for a number of inappropriate

reasons, which will be discussed in turn. However, applicant's representative would like to note that the Examiner has merely issued boilerplate arguments without any facts or analysis to support her reasoning, which is improper. The Examiner cannot merely make conclusory statements about perceived shortcomings of the declaration without supporting those statements with actual analyses and facts, and this the Examiner has not done.

First, the examiner argues that the declaration is inappropriate under 37 C.F.R. 1.131(a) when the reference is *claiming* the same patentable invention (see paragraph 2 on page 2 of the Office action). Rule 131(a) states that prior invention "may not be established under this section if... [t]he rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which *claims the same patentable invention* as defined in § 41.203(a) of this title, in which case an applicant may suggest an interference pursuant to § 41.202(a) of this title".

However, the Examiner has not shown that the application *claims* the same invention as the Fraccaroli reference (which has since matured into an issued patent), and, in fact, the Examiner does not discuss the claims at all. The current application claims a very different invention than Fraccaroli, as every Fraccaroli claim recites a limitation of "wherein said match is based on sequentially expanding a matching area until said match occurs, up to a threshold distance from said relative location of said mobile device". This matter is not claimed in the current application claims, and thus an interference is not the proper venue to address prior inventorship for this matter. Accordingly, the Examiner must withdraw this objection to the declaration.

The Examiner has also argued that the evidence is insufficient to establish conception of the invention, arguing that conception must be capable of proof using demonstrative evidence or by a disclosure to another (see paragraph 3, page 2 of the Office action). The Examiner further argues that a vague idea of how to solve a problem is not sufficient, and that the invention was not conceived prior to the date of the Stuart [sic] reference.

But the Examiner fails to show where the supplied evidence does not support the invention, as no factual analysis was provided by the Examiner to support her arguments. Applicant has provided a detailed mapping of the evidence supporting the declaration to the claimed subject matter, but the Examiner has not shown what part of the evidence is insufficient.

Furthermore, the declaration is itself evidence that the invention was within the grasp of the inventors, and the supplied evidence is merely some documented support for the dates when this was the case. There is no requirement that the applicant provide irrefutable proof of conception in the form of documented evidence. Instead, the rule merely requires that the showing of facts “shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference”. In this case, the supplied evidence and mapping supports the declaration of the inventors, and thus the requirement of the rule is met. Applicant cannot address issues that were not raised by the Examiner, and the Examiner has failed to point out claim limitations where a lack of factual basis exists.

Furthermore, the Examiner has not rejected any claims based on any “Stuart” reference, and thus does not understand her referencing that reference.

Accordingly, the examiner must withdraw this objection to the declaration, or else provide supporting factual analysis to support her objections.

The Examiner also argued that the submitted evidence fails to establish diligence from the asserted date of prior inventorship to the construction reduction to practice (see paragraph 4 on page 3 of the Office action). Rule 131(a) requires that applicant show “due diligence from prior to said date to a subsequent reduction to practice or to the *filing of the application*” (emphasis added). Applicant’s representative notes that applicant is asserting a date of inventorship prior to May 19, 1999, and that this application claims priority from a foreign patent application filed on September 29, 1999. Thus, there is less than four and one-half months difference between these dates. How the Examiner can consider such a short length of time evidence of lack of diligence is not explained in her response, but it is clear that the issue of due diligence is not raised by this length of time. Filing an application more than five months from a date of disclosure of the invention is not unusual, and in fact filing in less than five months is probably faster than normal, as patent applications often take many weeks to prepare and file, and patent practitioners often cannot immediately prepare applications due to current workloads. Thus, it is the opinion of applicant that a period of less than five months is more than sufficient to show diligence, and thus this objection of the Examiner should be withdrawn.

The Examiner also argues that the evidence submitted is insufficient to establish a

reduction to practice of the invention in this, or a NAFTA or WTO member country, prior to the effective date of the Stuart [sic] reference (see paragraph 5 on page 3 of the Office action). First, as stated above, there are no outstanding rejections based on any Stuart reference, which the Examiner identifies as being U.S. Pat. App. 2002/0101858. Furthermore, the declaration states that the invention was conceived of in Switzerland, which is a WTO member country. Furthermore, it is applicants assertion that the supporting evidence provided with the Declaration, as supported by the providing mapping to the claims, is sufficient to support a constructive reduction to practice as of the asserted date of invention, sufficient to meet the requirements of 35 U.S.C. §112, first paragraph. The Examiner's arguments are all directed toward an actual reduction to practice, when only a *constructive* reduction to practice is necessary to support inventorship. Accordingly, arguments requesting a machine, an article of manufacture, or a composition of matter are not relevant, nor necessary, nor even claimed. Furthermore, it is noted that the supporting evidentiary materials provide a diagram showing a system design for the claimed method, and the mapping of the evidence to the claims supports a constructive reduction to practice that would support the current claim language. The Examiner has provided no factual support for any inadequacies of the provided evidentiary material to support her rejections. Accordingly, this objection to the declaration must also be withdrawn.

Accordingly, for the above discussed reasons, the Examiner must accept the provided declaration as supporting the claim of prior inventorship, or else provide a factual basis for her objections that goes beyond conclusory statements without any factual basis. Absent such a showing, the Fraccaroli and Hertz references cannot be considered prior art, and thus claims 1-32 and 34-53 are patentable over those references.

Finally, new claim 54 recites a method for finding members of a common interest group with the method including the steps of "providing a database for storing identifying characteristic about each of said members, said identifying characteristic being a picture of said members" and "said mobile device of the one of said members displaying said identifying characteristic to the one of said members for enabling identification of the another of said members by the one of said members", subject matter that is not taught by any of the previously cited references, individually or in combination, and thus new claim 54 is patentable over the references.

In consideration of the foregoing analysis, it is respectfully submitted that the present

application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. P&TS-33835.

Respectfully submitted,

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